

REMARKS

Claims 1-29 and 31-34 were pending in the application. Claims 1-20, withdrawn from consideration as directed to non-elected inventions, have been cancelled without prejudice. New claims 35-37 have been added. Claim 31 has been amended.

Claim 31 was amended to remove reference to a Markush group and to provide a generic claim. New claim 35 further identifies the DKFZ antisense polynucleotides. New claim 36 sets forth the Markush group previously present in claim 31. New claim 37 further identifies the activity set forth in claim 21.

Support for the amendments to claim 31 as well as for new claims 35-37 can be found throughout the application as originally filed, including, for example, in the as-filed claims, Tables 7, 7A, 9 and 10, page 48, lines 30-34, and page 63, line 28 to page 64, line 2.

No new matter has been added.

Upon entry of this amendment, claims 21-29 and 31-37 will be pending.

Restriction Requirement

Claim 31 is subject to a further restriction requirement. The Examiner alleged that the claim "is not considered to be a proper genus/Markush". Although noting that if "the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits ...", the Office asserted that claim 31 did not fall into this exception. Specifically the Office alleged out that each member of the Markush group had a unique nucleotide sequence and each member modulates DKFZ expression to a different degree, citing Applicant's Table 7. Applicants do not agree with the Office's conclusion.

First, Applicant respectfully points out that there are only two members of the Markush group, seeming to clearly satisfy part one of the stated criteria necessary for an examiner to search the entire claim ["if the members of the Markush group are sufficiently few in number"].

Indeed, there could not be fewer members of a Markush group. Additionally, Applicant notes that the two members of the Markush group are related – each is an oligonucleotide sequence corresponding to the DKFZ gene and each significantly inhibits DKFZ expression. Applicant points out that as shown in cited Table 7, SEQ ID NO:508 inhibits expression by 99.3% while SEQ ID NO:510 inhibits expression by 97.9%. Applicant does not believe that the degree of difference between 99.3% and 97.9% represents a substantial difference in activity. Applicant also notes that the language cited by the Office about situations allowing the search of an entire claim containing a Markush group includes the term “or”. Accordingly, either having sufficiently few members of the Markush group *or* having closely related members of the Markush group is sufficient for the exception allowing search of an entire Markush group to take place. Applicant respectfully asserts that at least one of the stated conditions has been satisfied. Accordingly, Applicant respectfully assert that the entire scope of claim 31 should be searched.¹

Although Applicants respectfully traverse the restriction requirement on the grounds that the Restriction Requirement is moot as it applies to claim 31, herein amended, and on the grounds that examining the entire scope of claim 31 is contemplated by MPEP 803.02, Applicants provisionally elect herein SEQ ID NO:508.

Applicants reserve the right to prosecute the claims encompassed by any of the non-elected groups in future divisional applications.

Related Applications

Applicants call the Examiner's attention to the following related application: 10/948,737 (filed September 22, 2004). This application is available in PAIR and the Examiner is encouraged to review it.

¹ Applicants note that claim 31, as amended, no longer recites a Markush group. New claim 36 recites the Markush group previously in claim 31.

PP017767.0004; 20366-124US1
SERIAL NO.: 10/501,187

PATENT
FILED: January 13, 2006

Conclusion

The examination of the pending claims and passage to allowance are respectfully requested. An early Notice of Allowance is therefore earnestly solicited. Applicant invites the Examiner to contact the undersigned at (302) 778-8458 to clarify any unresolved issues raised by this response.

Respectfully submitted,



Gwilym John Owen Attwell
Registration No. 45,449

Date: February 8, 2008
Fish & Richardson P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022
Telephone: (302) 652-5070
Facsimile: (877) 769-7945

80055529.doc